

REMARKS

Applicants have carefully reviewed the Office Action dated November 27, 2003. Applicants have amended Claims 1, 2, 3, 6, 7, 8, 10, 11, 16 and 17 to more clearly point out the present inventive concept. Claim 15 has been canceled to further the prosecution of this Application. Reconsideration and favorable action is respectfully requested.

Claims 1-19 stand rejected under U.S.C. §112, second paragraph, as being indefinite. Applicants have carefully reviewed the claims and have amended the claims to insure that all antecedent basis problems are addressed. Applicants believe that the claims are now consistent. The Examiner has further noted the limitation "the user location" as having inconsistent descriptive limitations. The user location is noted as being a location on a network to which information is forwarded and from which information is transmitted. There are operations that occur at the user location which could be facilitated with a computer or the such. Applicants believe that it is not necessary to further limit the claims to specifically require that a computer be utilized for the operation at the user location. Applicants believe that this language with respect to the amended claims is clear. With respect to "perceivable code," this is directed toward the concept that a user can perceive this code, since the code is output within the audio/video bandwidth of the media, i.e., it must be able to either be viewed by a user or heard by a user. Applicants have further amended the claims to refer to this as "user perceivable," although Applicants believe that this is a clarification and it is not necessary. The claims clearly refer to the unique perceivable code as being output during normal playback of the digital recorded video information within the "video/audio bandwidth thereof." As such, the language is considered by Applicants to be clear with respect to the fact that this perceivable code is something that the user must be able to perceive, either audibly or digitally. As such, this would not be inclusive of digital information that is encoded within the vertical blanking interval, conventionally referred to as a "VBI" system. This digitally encoded information requires a special encoder that must be embedded within the receiving apparatus in order to extract the information. This is a very conventional and well-known type of control mechanism. With the amendments, Applicants believe that 35 U.S.C. §112 rejection has been

AMENDMENT AFTER FINAL
Serial No. 09/378,218
PHLY-24,706

Page 8 of 12

overcome and, therefore, respectfully request withdrawal of such with respect to the remaining Claims of 1-19.

Claims 1-19 stand rejected under U.S.C. §103(c) as being unpatentable over *Portuesi*, U. S. Patent No. 5,774,666 and also in view of *Sherman*, U. S. Patent No. 5,213,337, and *Hudetz et al.*, U. S. Patent No. 5,978,773 and further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made. This rejection is respectfully traversed with respect to the amended claims.

Applicants present inventive concept as defined by the amended claims herein, is directed toward a system wherein a video media can be distributed with information embedded within the audio/video bandwidth thereof in the form of a user perceivable code. When this audio or video is played back in a conventional machine or any machine, this user perceivable code will be output as a result of this playback. This user perceivable code is output in the audio/video bandwidth of the media such that it can be heard by the user. It is not that the user needs to view this or hear this; rather, it is in the audio/video bandwidth for the purpose of insuring that it will be output. If it were encoded in a band above the conventional audio or video band, this could potentially cause a problem in playback. The reason is that some systems may not have the bandwidth to actually output the information for retrieval therefrom or, if digitally encoded such as a VBI system, it may not have the digital decoders associated therewith. Once the information is output, during playing of the digital video disk, this information can therefore be utilized in accordance with the claim language that claims effecting in connection with a remote location on the Internet or network for the purpose of returning information to the user location for use by the computer. Further, the claims set forth that this user perceivable code is transmitted to an intermediate location, after decoding thereof, for the purpose of performing a lookup in an associative database at the intermediate location and then returning routing information to the vendor location.

The *Portuesi* reference is a reference that is directed toward providing a media which has encoded therein URL information. In Column 9, Lines 17-21, it is disclosed that a video signal containing both the embedded URL information and the video track could be recorded after

assembly on a fixed storage media such as the VCR tape or video disk, and then this media can be distributed. However, this media does not have "perceivable" code within the audio/video bandwidth thereof. Specifically, this system is a VBI system that converts embedded URLs into digital information that is transmitted "along with" with the video signal. (Column 9, Lines 1-8.) As such, this reference specifically teaches away from embedding the URL within the audio/video bandwidth of the video track, after modification thereof. Further, all *Portuesi* does with the extracted information, even though it would be from a non-perceivable portion of the media, is to display that information. There is another action that must be performed in order to actually utilize the URL to make a connection. There must be some participation on the part of the user in the operation of selecting the URL and connecting to a web site. In contra distinction, Applicants' present inventive concept, allows the distributor of a video program to automatically output the user perceivable code and, if the extractor is operating, to automatically make a connection to a vendor web site for the purpose of downloading information. Therefore, it is the action of playback that causes the web connection to be made and not the user intervention. As such, all *Portuesi* discloses is display of a URL in response to extraction of a non-perceivable code and not connection. There is no suggestion in *Portuesi* to make the connection in response to the playback. In fact, the object of *Portuesi* is to associate the content being displayed with a particular URL at a particular time in the program, this being a time sensitive operation. Therefore, there must be some association between what is being displayed and the user's reaction to that in order for the user to actually select the "hot spot" in order to effect a connection. This would effectively teach away from an automatic operation wherein the connection is made in response to the step of extracting.

The *Sherman* reference was added by the Examiner and provides an "essentially" non-perceivable code, but the code is actually available as it is in-hand. There is some suggestion to stall the broadcast for later viewing on a video tape (Column 2, Lines 30-31). However, this broadcast and the tones output therefrom are not used to effect any connection to a remote location; rather, they are output for the purpose of controlling a game. As such, *Sherman* is not believed to be more relevant than *Portuesi*. Applicants would like to bring to Examiner's attention U. S. Patent No. 6, 003,073, issued to *Solvason* on December 14, 1999, which was provided in an Information Disclosure Statement, which is a system that utilizes embedded audio signals that are perceivable

AMENDMENT AFTER FINAL
Serial No. 09/378,218
PHLY-24,706

Page 10 of 12

and which are utilized to effect a connection with a remote location, but the codes are not transmitted to an intermediate location; rather, a lookup is performed in the computer on the local disk. Further, this information is in a broadcast program and not embedded in a media. This is similar to the *Hudetz* reference in that a lookup is performed, but in a slightly different manner.

Applicants believe that what is not taught by the combination of any of the cited references is the distribution of a digital video disk having embedded within the audio/video bandwidth of the contents to be played back "perceivable" codes that can be extracted during playback and then a system controlled to automatically "jump" to a vendor location or the such. As such, Applicants believe that neither *Portuesi*, *Sherman* nor *Hudetz*, taken singularly or in combination, render Applicants present inventive concept obvious or unpatentable. Therefore, Applicants respectfully request withdrawal of 35 U.S.C. §103 rejection with respect to the remaining of Claims 1-19.

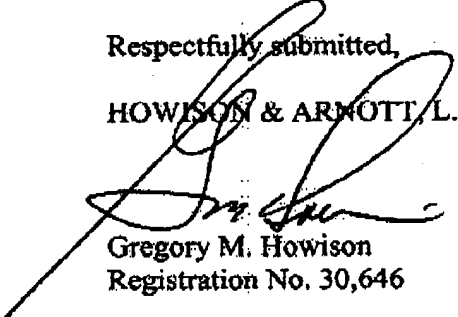
Applicants note with appreciation the Examiner's indication that Claims 3 and 8 will be allowable if rewritten in independent form to incorporate the limitations of the base claim and any intervening claims. Applicants believe that the claims as presented are now allowable and, therefore, have not amended the claims as such.

Applicants note with appreciation the Examiner's detailed attention to the claims and the legal route associated therewith.

Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-24,706 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,

HOWISON & ARNOTT, L.L.P.


Gregory M. Howison
Registration No. 30,646

GMH/yoc
P.O. Box 741715
Dallas, Texas 75374-1715
Tel: 972/479-0462
Fax: 972/479-0464
December 31, 2003

AMENDMENT AFTER FINAL
Serial No. 09/378,218
PHLY-24,706

Page 12 of 12